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PATENT
Attorney Docket No.: SLM-06400

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David T. Amm, *et al.*

Serial No.: 09/930,838

Filed: August 15, 2001

For: **BLAZED GRATING LIGHT
VALVE**

Group Art Unit: 2872

Examiner: John Juba Jr.

**PETITION UNDER 37 C.F.R. § 1.181
AND 35 U.S.C. §122(b)(2)(B)(iii) FOR
ACCEPTANCE OF LATE NOTICE OF
FOREIGN FILING**162 N. Wolfe Road
Sunnyvale, California 94086
(408) 530-9700Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**RECEIVED**

JUN 09 2003

OFFICE OF PETITIONS

Sir:

The applicants hereby petition under 37 C.F.R. § 1.137, 37 C.F.R. § 1.181 AND 35 U.S.C. §122(b)(2)(B)(iii) for acceptance of late notice of foreign filing. It was unintentional that this notice of foreign filing was filed late. A petition fee under 37 C.F.R. § 1.17(m) of \$1300.00 is also enclosed.

The American Inventors Protection Act of 1999 (Public Law 106-113) initiated provisions for eighteen-month publication of applications under 35 U.S.C. § 122(b). An applicant can request non-publication of an application, if an application is not foreign filed. 35 U.S.C. §122(b)(2)(B)(i) However, it is specified that if an applicant has made a request for non-publication and then files a corresponding foreign application, then the Director of the Patent and Trademark Office (USPTO) must be notified within 45 days after the date of such foreign or international application. 35 U.S.C. §122(b)(2)(B)(iii) The applicant may rescind a request for non-publication. 35 U.S.C. §122(b)(2)(B)(ii) The initial form (PTO/SB/36) published by the USPTO only included the rescission of the non-publication request. The USPTO also published a presentation entitled "Implementation of the American Inventors Protection Act of 1999 (Public Law 106-113) and the Patent Business Goals," April 23, 2001, which is still downloadable on the USPTO website, which includes the original form (PTO/SB/36) with only the rescission of the non-publication request language. This original form (PTO/SB/36) did not include a notice of foreign filing. A Pre-OG Notice entitled "Reminder That Rescission Of A

Adjustment date: 00/00/0000
06/09/2003 AWONDAF1 00000126 09930838
01 FC:1453 -1300.00 OPRepln. Ref: 06/27/2003 CKHLOK 0015175700
Date: 081275 Name/Number: 09930838
FC: 9204 \$1300.00 CR

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06/09/2003 AWONDAF1 00000126 09930838
01 FC:1453 1300.00 OP


Non-publication Request Is Not Itself A Notice Of Foreign Filing," published on the USPTO website, then clarified the current position of the USPTO that a request to rescind a request for Non-publication is not a notice of foreign filing. This Pre-OG Notice includes reference to a new form (PTO/SB/36) which includes both the request to rescind and a notice of foreign filing, with a caution that if a notice of foreign filing is not filed within 45 days of foreign or international filing, then the application is considered abandoned.

In the present application, a Request for Non-Publication was filed with the original application papers on August 15, 2001. An International application was then filed for the invention of this application on July 26, 2002. On May 14, 2002, within 45 days of the foreign filing, a Request to Rescind the Non-Publication Request was filed in this application. When this Request to Rescind was filed, Applicant's attorneys used the language from the original USPTO form (PTO/SB/36), which included only the rescission of the non-publication request. It was not until reading the Pre-OG Notice entitled "Reminder That Rescission Of A Non-publication Request Is Not Itself A Notice Of Foreign Filing," published on the USPTO website, that Applicant's attorneys realized that the USPTO position was that a request to rescind within 45 days of foreign filing, was not a notice of foreign filing.

Upon discovering the changed USPTO position on this issue and that the initially published USPTO form (PTO/SB/36) is not now acceptable as notice under 35 U.S.C. §122(b)(2)(B)(iii) as it did not include the proper notification of foreign filing, I immediately began searching the files of this firm for any affected cases and then prepared this petition. Accordingly, this late filing of the notice of foreign filing was not intentional. Applicants and their attorneys respectfully request that this petition is granted and notice of such is promptly returned to Applicants' attorneys.

Respectfully submitted,
HAVERSTOCK, & OWENS LLP

Dated: 6-3-03

By: 
Thomas B. Haverstock
Reg. No. 32,571

Attorneys for Applicants

CERTIFICATE OF MAILING (37 CFR § 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the:
Commissioner for Patents, P.O. Box 1450
Alexandria, VA 22313-1450

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HAVERSTOCK & OWENS LLP.
Date: 6-3-03 By: 